

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

## RENEWAL SERVICES

Plaintiff,

CASE NO. 15cv1779 WQH  
(DHB)

UNITED STATES PATENT AND  
TRADEMARK OFFICE,

Defendant.

## ORDER

HAYES, Judge:

The matter before the Court is motion to dismiss, or in the alternative, for summary judgment (ECF No. 5) filed by the Defendant.

## I. Procedural Background

On August 13, 2015, Plaintiff Renewal Services (“Renewal”) filed the Complaint against Defendant United States Patent and Trademark Office (“USPTO”) pursuant to the Freedom of Information Act (“FOIA”), 5 U.S.C. § 552. (ECF No. 1). On February 11, 2016, Defendant filed a motion to dismiss pursuant to Federal Rule of Civil Procedure 12(b)(1) and 12(b)(6) or in the alternative, for summary judgment pursuant to Federal Rule of Civil Procedure 56(c). (ECF No. 5). On March 7, 2016, Plaintiff filed an opposition. (ECF No. 6). On March 14, 2016, Defendant filed a reply. (ECF No. 7).

1      **II.    Allegations of the Complaint**

2      Plaintiff filed this action “seeking the disclosure and release of agency records  
 3    . . . improperly withheld . . . by the United States Patent Office.” (ECF No. 1 at 1). In  
 4    a letter to the USPTO dated October 24, 2014, Plaintiff requested “documents  
 5    containing correspondence addresses, issuance date, and patent number for all patents  
 6    issued in on or after January 1, 2002” pursuant to the FOIA.<sup>1</sup> (ECF No. 5-3 at 2).  
 7    Plaintiff stated in the letter,

8      [P]ublic access to the requested information is technically possible via  
 9    your Patent Application Information Retrieval (PAIR) system. However,  
 10   the procedure has proven prohibitively cumbersome to enterprises such  
 11   as my client’s. In fact the current means required to pull this public  
 12   information from your system requires searchers to possess certain input  
 13   codes such as a patent number, control number, or a publication number.  
 14   . . .

15   Our client has engineered a valuable service already proven to efficiently  
 16   facilitate the periodic renewal of inventor’s patent licenses. This,  
 17   however, requires ready and efficient access to inventor’s correspondence  
 18   addresses. While the PAIR system is, unfortunately, useless to our client’s  
 19   business needs it does illustrate that the risk to inventors’ correspondence  
 20   address information will not be further impinged by our client’s practices.

21   *Id.*

22   On November 13, 2014, in response to the October 24, 2014 letter, the USPTO  
 23   stated that it was not obligated to provide the requested information pursuant to the  
 24   FOIA. *Id.* at 7. The USPTO stated, “The United States Patent and Trademark Office  
 25   (USPTO) maintains that the records you seek are available in public patent application  
 26   files and not subject to a FOIA request. Because these files are indexed and open to

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27   <sup>1</sup>The Court takes judicial notice of the letters between Plaintiff and Defendant  
 28   whose content are alleged in the Complaint and whose authenticity no party questions.  
 29   The letters are attached to Defendant’s Motion to Dismiss or for Summary Judgment  
 30   (ECF No. 5). Under the doctrine of incorporation by reference, “[a] district court ruling  
 31   on a motion to dismiss may consider documents whose contents are alleged in a  
 32   complaint and whose authenticity no party questions, but which are not physically  
 33   attached to the plaintiff’s pleadings.” *Parrino v. FHP, Inc.*, 146 F.3d 699, 705 (9th Cir.  
 34   1998) (internal quotation marks omitted). The “incorporation by reference” doctrine  
 35   has been extended “to situations in which the plaintiff’s claim depends on the contents  
 36   of a document, the defendant attaches the document to its motion to dismiss, and the  
 37   parties do not dispute the authenticity of the document, even though the plaintiff does  
 38   not explicitly allege the contents of that document in the complaint.” *Knivele v. ESPN*,  
 39   393 F.3d 1068, 1076 (9th Cir. 2005).

1 public inspection pursuant to 5 U.S.C. § 552(a)(2), they are not available in response  
 2 to a FOIA request made under 5 U.S.C. § 552(a)(3).” *Id.*

3 On March 9, 2015, in a letter to the USPTO, Plaintiff made another request for  
 4 the correspondence addresses of patent holders. Plaintiff stated,

5 Our client’s present need arose subsequent to your office having  
 6 discontinued and eliminated, in October of 2010, the inclusion of an  
 7 inventor’s mailing address on patents and application publications. While  
 8 this was done in the interest of inventors’ privacy concerns, the public  
 9 interest in allowing our client access to this information outweighs any  
 10 risks to the privacy interests of patent holders. . . .

11 Public access to the names and addresses of individuals who have had  
 12 patents awarded is technically available via the US Patent Office  
 13 (“USPTO”)’s Patent Application and Information Retrieval (“PAIR”)  
 14 system. By pulling up individual files, any public user can see the initial  
 15 address used at the time the patent application was filed. *Davis v. United*  
*16 States Dep’t of Justice*, 968 F.2d 1276, 1279 (D.C. Cir. 1992) (FOIA  
 17 exemptions cannot be used to shield information already in the “public  
 18 domain”). Moreover, the USPTO does provide bulk data that includes the  
 19 name, patent number, and city and state of the patent holder - the vast  
 20 majority of the information necessary to ascertain and contact patent  
 21 holders. The only information omitted from the bulk disclosure at this time  
 22 is the home address line and zip code.

23 *Id.* at 9-10.

24 On April 7, 2015, the USPTO responded and denied Plaintiff’s request stating,

25 The U.S. Patent and Trademark Office (USPTO) indexes and makes  
 26 available for public inspection and copying all files concerning issued  
 27 patents and published applications, as well as re-examination files. . . .  
 28 The USPTO’s indices include: (1) an index of patents by application  
 29 number, patent number, or control number; (2) an inventor’s index; and  
 30 (3) an index of assignor/assignees of patents. The documents you seek  
 31 would be found in these files. Inventor’s names and addresses are listed  
 32 in the Inventor’s Oath/Declaration of each issued patent and can be viewed  
 33 in public PAIR.

34 (ECF No. 5-3 at 15).

35 On May 6, 2015, Plaintiff filed an administrative appeal explaining that, the  
 36 USPTO’s “response does not address the . . . excessively onerous method for extracting  
 37 information, nor does it address the fact that addresses and zip codes are excluded from  
 38 the bulk data currently offered by the USPTO.” *Id.* at 18. Plaintiff stated, “Right now,  
 39 by pulling up individual files, any public user can see the initial address used at the time  
 40 the patent application was filed. Bulk data available through the USPTO, however

1 excludes the address and zip code related to patents.” *Id.* at 18.

2 On June 5, 2015, Defendant denied the administrative appeal stating,

3 The Freedom of Information Act, at 5 U.S.C. § 552(a)(3), requires Federal  
 4 agencies to make ‘records’ available to requestors. However, Section  
 5 552(a)(3)(A) exempts from that requirement ‘the records made available  
 6 under paragraphs (1) and (2) of this subsection,’ referring to Section  
 7 552(a)(1) and (2). As explained in the initial determination, the USPTO  
 8 ‘indexes and makes available for public inspection and copying all files  
 9 concerning patents and published applications.’ You were specifically  
 10 advised: ‘Inventors’ names and addresses are listed in the Inventor’s  
 11 Oath/Declaration of each issued patent and can be viewed in public PAIR.’

12 The information you have requested is contained in documents made  
 13 available to the public in public PAIR. Because the Agency publishes and  
 14 indexes documents pertaining to patents in public PAIR, those documents  
 15 fall within 5 U.S.C. § 552(a)(2). . . . Consequently, those public PAIR  
 16 records, which include within them the information that you have  
 17 requested, are not subject to further release under Section 552(a)(3).

18 *Id.* at 22.

19 The Complaint asserts that Plaintiff has the right to the “prompt access to the  
 20 requested records under 5 U.S.C. § 552(a)(3)(A)” and that “[t]he USPTO has  
 21 wrongfully withheld the sought-after records from Plaintiff.” (ECF No. 1 at 4).  
 22 Plaintiff requests that this Court “order Defendant to disclose requested records in their  
 23 entireties and make electronic copies available to Plaintiff.” *Id.* at 4.

### 17 III. Legal Standards

18 Federal Rule of Civil Procedure 12(b)(6) permits dismissal for “failure to state  
 19 a claim upon which relief can be granted.” Fed. R. Civ. P. 12(b)(6). Federal Rule of  
 20 Civil Procedure 8(a) provides that “[a] pleading that states a claim for relief must  
 21 contain . . . a short and plain statement of the claim showing that the pleader is entitled  
 22 to relief.” Fed. R. Civ. P. 8(a)(2). “A district court’s dismissal for failure to state a  
 23 claim under Federal Rule of Civil Procedure 12(b)(6) is proper if there is a ‘lack of a  
 24 cognizable legal theory or the absence of sufficient facts alleged under a cognizable  
 25 legal theory.’” *Conservation Force v. Salazar*, 646 F.3d 1240, 1242 (9th Cir. 2011)  
 26 (quoting *Balistreri v. Pacifica Police Dep’t*, 901 F.2d 696, 699 (9th Cir. 1990)).

27 “To survive a motion to dismiss, a complaint must contain sufficient factual  
 28 matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’”

1 *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Twombly*, 550 U.S. at 570). “A  
 2 claim has facial plausibility when the plaintiff pleads factual content that allows the  
 3 court to draw the reasonable inference that the defendant is liable for the misconduct  
 4 alleged.” *Id.* (citation omitted). “[T]he tenet that a court must accept as true all of the  
 5 allegations contained in a complaint is inapplicable to legal conclusions. Threadbare  
 6 recitals of the elements of a cause of action, supported by mere conclusory statements,  
 7 do not suffice.” *Id.* (citation omitted). “When there are well-pleaded factual  
 8 allegations, a court should assume their veracity and then determine whether they  
 9 plausibly give rise to an entitlement to relief.” *Id.* at 679. “In sum, for a complaint to  
 10 survive a motion to dismiss, the non-conclusory factual content, and reasonable  
 11 inferences from that content, must be plausibly suggestive of a claim entitling the  
 12 plaintiff to relief.” *Moss v. U.S. Secret Serv.*, 572 F.3d 962, 969 (9th Cir. 2009)  
 13 (quotations and citation omitted).

14 **IV. Contentions of the Parties**

15 Defendant moves to dismiss the Complaint for lack of subject matter jurisdiction  
 16 and failure to state a claim, or, in the alternative, for summary judgment. Defendant  
 17 contends that the information requested in the Complaint is publicly available and  
 18 indexed, in full compliance with § 552(a)(2) through the PAIR system. Defendant  
 19 contends that it has no obligation under the FOIA to make additional accommodations  
 20 pursuant to § 552(a)(3) so that Plaintiff’s access to the publicly available information  
 21 is less cumbersome. Defendant further asserts that the addresses for all patent holders  
 22 are publicly available and indexed in compliance with the FOIA and that the agency  
 23 has no obligation to provide the same information in bulk data.

24 Plaintiff contends that it has properly stated a FOIA claim by pleading that the  
 25 PAIR system has an excessively onerous method for extracting information and that the  
 26 USPTO’s withholding of correspondence addresses in bulk data is improper. Plaintiff  
 27 contends that the privacy concerns of inventors are not sufficient for the Defendant to  
 28 withhold the addresses from the bulk data. Plaintiff contends that Defendant is required

1 to release records in a less cumbersome manner pursuant to 5 U.S.C. § 552(a)(3).

2 In reply, Defendant contends that the agency has fully disclosed the requested  
 3 information under § 552 (a)(2) and that § 552 (a)(3) which requires agencies to provide  
 4 records in “any form or format requested” is inapplicable. 5 U.S.C. § 552(a)(3)(B).  
 5 Defendant asserts that it is not withholding the correspondence addresses based upon  
 6 privacy concerns because the addresses are publically available through public access  
 7 to the PAIR.

8 **V. Applicable Law**

9 The FOIA is a federal statute that sets forth the procedures and standards for  
 10 public release of executive agency records. 5 U.S.C. § 552. FOIA serves the purpose  
 11 of promoting transparency between the public and the actions taken by government  
 12 agencies. *See United States Dep’t of Justice v. Reporters Comm. For Freedom of Press*,  
 13 489 U.S. 749, 772 (1989) (explaining that the purpose of the FOIA is to “open agency  
 14 action to the light of public scrutiny” (internal quotation omitted)).

15 FOIA requires agencies to make certain records available for public inspection,  
 16 without a request pursuant to 5 U.S.C. § 552(a)(2). FOIA further includes provisions  
 17 for the public to request specific records pursuant to § 552(a)(3) when the information  
 18 is not already public pursuant to § 552(a)(2). 5 U.S.C. § 552(a)(3) states in relevant  
 19 part, “Except with respect to the records made available under paragraph (1) and (2) of  
 20 this subsection, ... each agency, upon any request for records . . . shall make the records  
 21 promptly available to any person.” 5 U.S.C. § 552(a)(3)(A).

22 **VI. Ruling of the Court**

23 “[F]ederal jurisdiction [pursuant to § 552(a)(4)(B)] is dependent upon a showing  
 24 that an agency has (1) ‘improperly’; (2) ‘withheld’; (3) ‘agency records.’” *Kissinger v.*  
*Reporters Committee for Freedom of the Press*, 445 U.S. 136, 150 (1980). In this case,  
 25 the Complaint alleges that access to the requested information is “possible via the  
 26 USPTO’s Patent Application Information Retrieval (“PAIR”) system.” (ECF No. 1 at  
 27 2). The Complaint contains factual allegations that PAIR contains correspondence

1 addresses, issuance dates and patent numbers for patents issued. The Complaint  
2 contains factual allegations that the information in the PAIR system is indexed using  
3 patent numbers, application numbers, and control numbers. (ECF No. 5-3 at 15). The  
4 facts alleged in the Complaint show that the requested information is available for  
5 public inspection, without a request, as required by § 552(a)(2).

6 5 U.S.C. § 552(a)(3) specifically provides that the agency need not respond to a  
7 § 552(a)(3) request for information when the same information is indexed and made  
8 public pursuant to the guidelines of § 552(a)(2). *See United States Dep't of Justice v.*  
9 *Tax Analysts*, 492 U.S. 136, 152 (1989) (“Under subsection (a)(3), the general  
10 provision covering the disclosure of agency records, an agency need not make available  
11 those materials that have already been disclosed under subsections (a)(1) and (a)(2).”)  
12 and *Leeds v. Commissioner of Patents and Trademarks*, 955 F.2d 757, 763 (D.C. Cir.  
13 1992) (“Because Rule 109 statements are already available under § 552(a)(2), they are  
14 specifically exempted from the category of documents that must be produced upon  
15 request under § 552(a)(3).”). Since the allegations of the Complaint in this case  
16 establish that Defendant has made the requested records publicly available and indexed,  
17 through electronic means, there are no facts alleged which would support the claim that  
18 the requested information is “improperly withheld” pursuant to 5 U.S.C. § 552(a)(3).  
19 Plaintiff has failed to allege facts or law which would support a claim that Defendant  
20 has improperly withheld bulk data information under the FOIA. The Complaint alleges  
21 facts which establish that the correspondence addresses are publicly available under §  
22 552(a)(2), and the Complaint fails to allege facts which support a claim that the  
23 correspondence addresses in the bulk data information is “improperly withheld”  
24 pursuant to 5 U.S.C. § 552. Plaintiff’s contention that privacy exemptions cannot  
25 justify the withholding of the addresses and zip codes from the bulk data is not  
26 applicable under the facts alleged in this Complaint. Exemptions only apply when there  
27 is a withholding of information. In this case, the facts alleged do not support a claim  
28 that the information is improperly withheld. *See Tax Analysts* 492 U.S. at 150

1 (“Congress used the word ‘withheld’ only ‘in its usual sense.’”). When the requested  
2 materials are made publicly available by the agency itself, the information is not  
3 withheld.

4 The Court concludes that the Complaint fails to allege facts to plausibly support  
5 a claim that Defendant has improperly withheld information under the FOIA, 5 U.S.C.  
6 § 552 .

7 **V. Conclusion**

8 IT IS HEREBY ORDERED that the Motion to Dismiss (ECF No. 5) is  
9 **GRANTED**. The Complaint is DISMISSED without prejudice.

10 DATED: June 29, 2016

11   
12 **WILLIAM Q. HAYES**  
13 United States District Judge

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